

Attorney Docket No.: 99.49US



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Application of Dreher, et al.

Group Art Unit: 1617

Serial No.: 09/482,773

Examiner: YU, Gina C.

Filed: January 13, 2000

For: **OPTICAL MAKEUP COMPOSITION**

APPELLANT'S BRIEF PURSUANT TO 37 CFR 1.191 AND 1.192

Commissioner of Patents
Attention: Board of Patent Appeals and Interferences
Alexandria, VA 22313-1450

Sir:

Appellants hereby appeal to the Board of Patent Appeals and Interferences from the final rejection of claims 1 to 34 in the present application in the decision of January 28, 2004.

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REAL PARTY IN INTEREST

The name of the real party in interest in this appeal is Color Access, Inc., the assignee of the application.

RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences relating to the instant application that would directly affect, be directly affected by, or have a bearing of any kind on the Board's decision in this appeal that are known to Appellants.

STATUS OF THE CLAIMS

Claims 1 to 11 remain pending in this application, and are included in this Appeal. In Appellants' Amendment mailed September 13, 2001, claims 20 and 21 were amended. The claims were further amended in the Amendment mailed on March 29, 2002. Appellants amended claim 1 again in the Amendment mailed on January 2, 2003. Claims 12, 14, 16, 21, 32 and 33 were amended in the Amendment mailed on June 24, 2004. Appellants now cancel claims 12 to 34 in an amendment being presented concurrently with this paper. Appellants reserve the right to file one or more further applications for the subject matter of canceled claims 12 to 34. A copy of all claims (1 to 11), pending in this Appeal, also is attached hereto.

STATUS OF AMENDMENTS

An Amendment under 37 C.F.R. 1.116, filed on June 24, 2004, was considered but in the Advisory Action mailed on August 16, 2004, it was stated that the proposed amendments (to claims 12, 14, 16, 21, 32 and 33) raise new issues that would require further consideration and/or search, and that they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.

SUMMARY OF THE INVENTION

The invention concerns a method of reducing the appearance of lines and wrinkles associated with aging of the skin. The method comprises applying to the skin exhibiting the lines and wrinkles a cosmetic composition comprising an interference pigment having a blue or violet reflectance combined with at least one metal oxide pigment. The cosmetic composition has a natural appearance on the skin; that is, when applied to the skin, the composition mimics the natural appearance of bare skin while providing sufficient coverage by taking advantage of the optical (e.g. light diffusing) properties of the cosmetic composition on the skin. The cited references fail to teach or suggest a method or reducing the appearance of lines and wrinkles associated with aging of the skin by applying to the skin exhibiting the lines and wrinkles a composition comprising an interference pigment having a blue or violet reflectance combined with at least one metal oxide pigment.

ISSUES

The remaining issues, after cancellation of claims 12 to 34, are whether claims 1-7 and 9-11 are rendered obvious by Kimura et al (U.S. Patent No. 5,690,916, hereinafter referred to as the '916 reference) in view of Hineno et al (U.S. Patent No. 6,207,174, hereinafter referred to as the '174 reference), and whether claim 8 is rendered obvious by the combination of the aforementioned references with Hurst ("Face Powders", Poucher's Perfumes, Cosmetics and Soaps, 1993, hereinafter the "Hurst" reference). Specifically, the question is whether one of ordinary skill in the art would have any expectation that applying the compositions of the '916 reference (for camouflaging red or blue discolorations of the skin) to age-wrinkled skin would, in view of the disclosure in the '174 reference, or the disclosures in the '174 reference and in the Hurst reference, have the effect of reducing the appearance of lines and wrinkles on age-wrinkled skin.

GROUPING OF CLAIMS

For purposes of determining patentability, claims 1 to 7 and 9 to 11; and 8, drawn to related issues of the present appeal, are grouped together and all grounds of rejection which Appellants contest apply to these claims. Specifically, claims 1 to 11 are grouped together as they apply to the grounds of rejection based on 35 U.S.C. § 103(a).

ARGUMENTS

The outstanding issues are whether claims 1 to 7 and 9 to 11 of the present application are rendered obvious by the '916 reference in view of the '174 reference, and whether claim 8 is rendered obvious by the aforementioned references in combination with Hurst ("Face Powders", Poucher's Perfumes, Cosmetics and Soaps, 1993, hereinafter the "Hurst" reference).

The present invention relates to a method of reducing the appearance of lines and wrinkles associated with aging of the skin, which method comprises applying to the skin exhibiting the lines and wrinkles a makeup composition comprising an interference pigment having a blue or violet reflectance, combined with at least one metal oxide pigment.

The Appellants traverse the Examiner's reasoning, with regard to the patentability of claims 1 to 7 and 9 to 11 that, although the '916 reference fails to teach using the compositions disclosed therein to visibly reduce wrinkles or lines caused by aging, since lines and wrinkles are obviously present in the mature users' skin, the application of the '916 composition to the mature users' skin would inherently render the desired wrinkle minimizing effect which Appellants claim, and further that, since the '174 reference teaches the use of composite powders comprising interference pigments useful in covering wrinkles and improving skin color (examples 1 and 2, Tables 2 and 3), it would have been obvious to one having ordinary skill in the art at the time the invention was made to have used the '916 reference compositions as motivated by the '174 reference because of the expectation of successfully enhancing the wrinkle coverage effect and improving skin color tone.

It is expressly taught in the '916 reference that the compositions disclosed therein are provided for adjusting skin color so that a hyperchromic portion of the skin can become inconspicuous by virtue of an interference action by a material in the compositions having a transmitted light component which is a complementary color to the color of the skin area to be adjusted (column 2, lines 25-29 of the reference). It is the Appellants' understanding

from this disclosure that the reference compositions are not intended to cover the discoloration, such as by using a skin-colored makeup, but, by reflecting a color complementary to the discoloration (interference effect), trick the viewer's eye into perceiving the discoloration as skin-colored. In fact, the reference teaches against using a composition with a high amount of pigment, such as would be used in a skin-colored foundation for covering over a blue or red discoloration, since the high amount of pigment would "spoil the transparent feel" of the composition (column 1, lines 59-63 of the reference).

The method step of applying the composition to age-wrinkled skin, a principal element of claim 1, is absent from the reference. The reference teaches only camouflaging a red or a blue hyperchromic portion (discoloration) of the skin. Nevertheless, the Examiner perceives that the missing step is inherent upon applying the '916 reference composition to age-wrinkled skin.

The well-known standard of inherency is set out in *Hughes Aircraft Co. v. United States*, 8 USPQ 2d 1580 (Ct Cls 1988): "...a finding of inherency requires that the intended result must undeniably and irrefutably flow from the prior disclosure". Moreover, as stated in *Continental Can Co. v. Monsanto*, 20 USPQ 2d 1746 at 1749: "To serve as anticipation when the reference is silent about the asserted inherent characteristic, such gap in the reference maybe filled with recourse to extrinsic evidence. Such evidence must make it clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill."

The Examiner has merely relied on personal opinion and has provided no extrinsic evidence as proof that one skilled in the art would expect that applying the '916 reference composition to discolored skin would necessarily result in its application to age-wrinkled skin.

That the step of applying the "916 reference composition to discolored skin might possibly also involve the application of the composition to age-wrinkled skin also is not

adequate to support a rejection based on anticipation by inherency. The court in *Eibel Process Co. v. Minnesota & Ontario Paper Co.*, 261 US 45, 66 (1923) held that accidental occurrences of the claimed subject matter, not intended and not appreciated, does not constitute anticipation.

In the absence of any teaching in the '916 reference that the composition should be applied to age-wrinkled skin, so that the natural result of the operation disclosed in the '916 reference would result in the claimed step of applying the composition to age-wrinkled skin, and in the absence of any showing of the Examiner by extrinsic evidence that all skin bears age-related wrinkles, any application of the reference composition to wrinkle skin is accidental and inadequate to support a conclusion of anticipation.

The '174 reference teaches compositions incorporating interference pigments which compositions may be used to camouflage wrinkles. Nevertheless, the only disclosure of wrinkle covering in the reference is in relation to the compositions of Example 1, including table 2 (columns 14-15) and Example 2, including table 3 (columns 15-16). Both compositions include a red, not a blue, interference pigment. In fact, the only disclosure at all of using a blue interference pigment can be found in Example 10. That example is not directed to any kind of a cosmetic composition.

Since the '916 reference is silent about reducing the appearance of age-related wrinkles on the skin, one skilled in the art would not look to this reference for guidance in to how to use the reference compositions to camouflage age-related wrinkles. The disclosure in the '174 reference does not cure the deficiency in the '916 reference, since it leads the skilled person to select red interference pigment for use in a composition suitable for reducing the appearance of wrinkles on the skin. The combination therefore does not result in the claimed method.

The Appellants further traverse the Examiner's reasoning regarding the patentability of claim 8 in view of the '916 reference in combination with the '174 reference in further combination with the Hurst reference.

Claim 8, which is appended to claim 1, requires the presence of bismuth oxychloride in the composition used in the method recited in claim 1. Neither the '916 reference nor the '174 reference teaches the use of bismuth oxychloride in the disclosed compositions. Hurst teaches the use of bismuth oxychloride, the first synthetic pearlescent pigment, to provide translucent luster or a frosted effect to enhance the wearer's natural complexion. The Examiner contends that it would have been obvious to have modified the composition of the combined '916 and '174 references as motivated by Hurst because of the expectation of successfully producing a composition with luster or frosted effect to enhance the natural look of the user.

As discussed above with respect to the rejection of claims 1 to 7 and 9 to 11, the combination of the '916 and '174 references is inadequate to support the rejection of claim 8, since a primary element of claim 1, to which claim 8 is appended, is not anticipated by or made obvious from the references. Specifically, the '916 reference does not teach the step of applying to the skin exhibiting age-related lines and wrinkles a makeup composition comprising an interference pigment having a blue or violet reflectance, combined with at least one metal oxide powder. The '174 reference only discloses wrinkle camouflage using a composition comprising a red interference pigment. Hurst merely discloses that bismuth oxychloride may be used in powders to provide luster. The combination does not therefore result in the claimed method.

CONCLUSION

In light of the arguments presented above, the obviousness rejection of claims 1 to 7 and 9 to 11, based on the '196 reference in view of the '174 reference, and the obviousness rejection of claim 8 in view of the aforementioned references in further combination with the Hurst reference, should be reversed as they are unfounded.

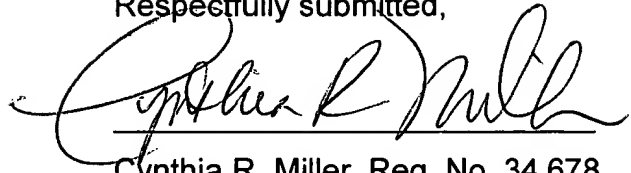
Regarding claims 1 to 7 and 9 to 11, one of ordinary skill in the art would not have looked to the '916 reference for guidance in preparing wrinkle-camouflaging compositions, since the reference is silent concerning wrinkles and is directed to adjusting the appearance of a hyperchromic portion of the skin by applying to the portion of the skin in need of color adjustment a composition containing an interference pigment of a complementary color to the color of the skin in need of color adjustment. The application of the compositions of the '916 reference to age-related wrinkles is neither taught in nor suggested by the reference. Moreover, the Examiner has provided no extrinsic evidence to prove that applying the compositions of the '916 reference to discolored skin necessarily brings about the claimed effect.

The disclosure in the '174 reference could only lead the skilled person to use a '916 composition with a red interference pigment to cover wrinkles.

Turning to the obviousness rejection of claim 8, the Hurst reference does not cure the deficiencies of the '916 and '174 references, since the Hurst reference is concerned with adding luster to powders and is entirely silent on reducing the appearance of age-related wrinkles in the skin.

Accordingly, the Appellants respectfully request that the Honorable Board reverse the decision of the Examiner finally rejecting the pending claims and declare that all the pending claims in this application are allowable.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Cynthia R. Miller', written over a horizontal line.

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APPENDIX: THE CLAIMS ON APPEAL

1. (previously presented) A method of reducing the appearance of lines and wrinkles associated with aging of the skin, which comprises applying to the skin exhibiting lines and wrinkles a makeup composition comprising an interference pigment having a blue or violet reflectance, combined with at least one metal oxide pigment.
2. (original) The method of claim 1 in which the interference pigment has a blue reflectance.
3. (original) The method of claim 1 in which the interference pigment has only a blue reflectance.
4. (original) The method of claim 1 in which the composition comprises titanium dioxide.
5. (original) The method of claim 1 in which the composition comprises titanium dioxide and iron oxide.
6. (original) The method of claim 1 in which the composition further comprises at least one inorganic, non-matte, non-spherical powder.

7. (original) The method of claim 6 in which the powder is selected from the group consisting of bismuth oxychloride, boron nitride, barium sulfate, mica, sericite, muscovite, synthetic mica, titanium oxide coated mica, titanium oxide coated bismuth oxychloride, titanium oxide coated talc, platelet iron oxides, aluminum powder, lauroyl lysine and platelet talc.

8. (original) The method of claim 1 in which the composition further comprises bismuth oxychloride.

9. (original) The method of claim 1 in which the composition comprises from about 1 to about 9% by weight of interference pigment.

10. (original) The method of claim 8 in which the composition comprises from about 2 to about 8% by weight of the interference pigment.

11. (original) The method of claim 10 in which the interference pigment has only a blue reflectance.